

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lyle E. Devore, Jr., et al	Group Art Unit: 2173
Serial No.: 10/674,127	Examiner: Watt, Chris A.
Filed: 9/29/03	Attorney Docket: 2063.013800
For: Method And Apparatus For Status Display With Intermediate Database Access	Client Docket: VS-00608C
	Confirmation #: 4275

**RESPONSE TO NOTICE
OF NON-COMPLIANT APPEAL BRIEF**

MAILSTOP: PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

On November 8, 2007, the Office mailed a “Notice of Non Compliant Brief” (the “Notice”). The Notice stated that the “Appeal Brief”, filed August 7, 2007, (the “Appeal Brief”) was “non-compliant” because “[e]very element of mean [sic] plus function claims needs to be literally defined within the specification.” Because this is not only contrary to the rule, but also to law, the undersigned telephoned the Examiner. On December 3, 2007, the undersigned spoke with the Examiner.¹ The Examiner stated this was indeed the reason the Appeal Brief was considered non-compliant. From this telephone conversation, Applicants understand that the Office is requiring that the Appeal Brief map all means-plus-function limitations to a statement in the specification stating something like, “Elements A, B, and C comprise a means for doing X”.

The Office’s error rests on two mistakes. The error first results from a conflation of the content requirements of the Appeal Brief with the statutory disclosure requirements for the

invention in the specification. The second mistake is that it applies the law regarding the statutory disclosure requirements incorrectly. When the rule promulgated by the Office is correctly applied in light of Office policy, it is apparent that the Appeal Brief complied therewith.

I. Applicants Have Complied With the Rules of Practice

The Office has set forth the requirements for the form and content of the Appeal Brief in 37 C.F.R. §41.37(c), which reads, in pertinent part:

Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, *every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.*

37 C.F.R. §41.37(c)(1)(v) (emphasis added). Note that the rule in no way purports to regulate the content of the specification. It should therefore be manifest that it cannot require that “[e]very element of mean [sic] plus function claims needs to be literally defined within the specification.”

Applicants have done precisely what the rule requires. (see “Appeal Brief”, filed August 7, 2007, pp. 2-12, and especially pp.6-12) For example, consider the mapping for claim 10:

With respect to **claim 10**, a computer-based system (e.g., 100, **FIG. 1**; ¶[0037]-¶[0038]) for presenting a selected one of a plurality display screens (e.g., 300, **FIG. 3A**; ¶[0052]-¶[0057]), the invention comprises:

means (e.g., 140, **FIG. 1**; ¶[0037]) for accessing (e.g., ¶[0039]) a plurality of information sources (e.g., 110, **FIG. 1**; ¶[0038]; 1140, 1140A-1140C, **FIG. 10B**; ¶[0099]-¶[0111]);

¹ No other parties participated. No claims were discussed on their merits and no art was discussed. Indeed, nothing substantive was discussed. The entire conversation was devoted to clarification of the Office’s position in the Notice.

means (e.g., 140, **FIG. 1**; ¶[0038]-¶[0039]) for generating (e.g., **FIG. 9**, ¶[0092]-¶[0097]) a plurality of display screens (e.g., 200, **FIG. 2**; ¶[0040]-¶[0051]), each display screen including at least one control (e.g., 220, **FIG. 2**; ¶[0041]-¶[0042]), each control having at least one function (e.g., ¶[0041]-¶[0042]) associated therewith, each display screen including at least one status indicator (e.g., 230, **FIG. 2**; ¶[0040]-¶[0041]; ¶[0047]-¶[0051]) associated with a status indicator threshold (e.g., ¶[0047], ¶[0051]);

means (e.g., 150, **FIG. 1**; ¶[0040]-¶[0041]) for selecting (e.g., ¶[0040]-¶[0041]) one of said plurality of display screens for display;

means (e.g., 150, **FIG. 1**; ¶[0040]-¶[0041]) for selectively activating (e.g., ¶[0040]-¶[0041]) a status indicator on said selected one of said plurality of display screens based on information located in at least one of said information sources and on at least one status indicator threshold;

means responsive (e.g., ¶[0041], ¶[0047], ¶[0053]) to a control on said selected one of said plurality of display screens, for invoking a function (e.g., ¶[0041], ¶[0047], ¶[0053]) associated with said control upon activation of said control; and

means (e.g., ¶[0099], ¶[0104]-[0105]) for linking an intermediate datasource (e.g., 1150, **FIG. 10B**; ¶[0099]-¶[0014], *esp.* ¶[0105]-¶[0106]) to at least one additional information source, and wherein at least one of said plurality of information sources is an intermediate datasource (e.g., 1150, **FIG. 10B**; ¶[0099]-¶[0014], *esp.* ¶[0105]-¶[0106]).

(“Appeal Brief”, pp. 6-7) The only other claim having means-plus-function limitations is claim 28. The means-plus-function limitations of this claim are mapped back into the specification with the same level of particularity and specificity.

Note that the disclosure for each of the mean limitations is “set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters”. The only exception being that the disclosure is mapped by paragraph as opposed to page and line number. This kind of mapping has been universally accepted by the Office as “compliant” for some time now. Accordingly, Applicants have fully complied with the requirements of 37 C.F.R. §41.37(c).

II. The Office Erroneously Conflates the Rule with a Statute

The rule cited by the Office therefore does not require that “[e]very element of mean [sic] plus function claims needs to be literally defined within the specification.” In the telephone

conversation alluded to above, the Examiner stated that Office personnel are acting in accordance with a recent court decision that 35 U.S.C. §112, ¶2 holding that the written description requirement for a means-plus-function limitation mandates a “direct link” between the claim language and the detailed description.

Note, however, that this is a product of the statute in 35 U.S.C. §112, ¶2, not 37 C.F.R. §41.37(c). As is established above, Rule 41.37 addresses only the form of the Appeal Brief. The requirements do not address the quality of the disclosure in the specification. The rule instead merely requires that Applicants on appeal map the claim language back into the detailed description. Thus, the Office is improperly conflating the rule regarding the form of the “Appeal Brief” with a supposed legal standard for the substantive disclosure of the application.

III. The Legal Standard the Office is Improperly Conflating is also an Incorrect Legal Principle

The legal standard that the Office is trying to conflate is also an improper legal standard. The law does not require that the specification of the application set forth a “direct link” to means-plus-function language in the claims in the manner that the Office is trying to enforce. For example, the federal courts have expressly held that such a “direct link” can be found in the prosecution history, as opposed to the specification:

Section 112, paragraph 6 states that a means-plus-function claim "shall be construed to cover the corresponding structure . . . described in the specification." (emphasis added). We hold that, pursuant to this provision, structure disclosed in the specification is "corresponding" structure *only if the specification or prosecution history* clearly links or associates that structure to the function recited in the claim.

B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1424 (Fed. Cir. 1997) (emphasis added). It is therefore clear that the direct link may be found in the prosecution history *instead of* the specification. *See also Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003); *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1208 (Fed. Cir. 2002). This accords with Office policy. *See* M.P.E.P. §21821 II.

IV. Applicants Comply with the Correct Statutory Requirement

As noted above, the statutory standard that the Office is mistakenly trying to enforce under 37 C.F.R. §41.37(c) states that there a direct link should be found between the claim language and the specification or prosecution history. Also as set forth above, Applicants have mapped each limitation of each element of each means-plus-function back into the specification. This constitutes just such a “direct link” in the prosecution history. Applicants have therefore complied with the correct statutory requirement.

V. The Office Failed to Follow Its Own Policy, and the Notice Therefore Presents an Arbitrary and Capricious Act

Office policy accords with the federal court decisions to the extent that the specification need not identify necessarily identify the underlying structure or acts that are claimed as “means” or “steps”. Office policy, in fact, is precisely the opposite:

The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function.

...The disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.

...Under certain limited circumstances, the written description does not have to explicitly describe the structure (or material or acts) corresponding to a means- (or step-) plus-function limitation to particularly point out and distinctly claim the invention as required by 35 U.S.C. 112, second paragraph. Under proper circumstances, drawings may provide a *written description of an invention as required by 35 U.S.C. 112. Rather, disclosure of structure corresponding to a means-plus-function limitation may be implicit in the written description if it would have been clear to those skilled in the art what structure must*

perform the function recited in the means-plus-function limitation.

M.P.E.P. §21821 II (citations omitted, emphasis added).

Office policy, as set forth in this provision clearly contemplates that means-plus-function limitations can be adequately supported in a substantive manner without any “direct link” at all. Applicant is unaware of any change to Office policy since the publication of this M.P.E.P. provision and the Office has not pointed to any. The failure of the Office to follow its own policy when that policy is clearly set forth is arbitrary and capricious in a manner that is clearly reversible in a manner reversible as a matter of law under even the highest standard of review in the federal courts.

VI. Conclusion

The Office is therefore erroneously attempting to enforce 37 C.F.R. §41.37(c) in a manner that is contrary to its own policy using an incorrect legal standard derived from an unrelated statutory provision. When 37 C.F.R. §41.37(c) is correctly applied, Applicants have complied with it in the Appeal Brief. When the statutory standard for written description of means-plus-function language is correctly applied, Applicants have complied with it as well. Applicants’ Appeal Brief complied with all applicable standards regarding the form thereof. Applicants therefore request that the notice be withdrawn and that the appeal be allowed to continue.

WILLIAMS, MORGAN & AMERSON
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Date: December 10, 2007

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